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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/061,064

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EXAMINER

PARRA, OMAR S

ART UNIT

PAPER NUMBER

2623

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/061,064	CRANDALL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	OMAR PARRA	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 2-16 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-16 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/19/2008</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/19/2008 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2-5, 12 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification fails to support:

- "...wherein the downloading begins after the recipient authorizes the downloading...", as recited on claims 2, 3, 4 and 5.
- "...further comprising the step of ending the downloading of the A/V file to the recipient data network address when the voice connection between the sender and the recipient ends", as recited on claims 12 and 16.

The specification discloses a sender sending an a/v file to a television server related to a recipient (305, Fig. 3; page 7 lines 154-page 8 line 176, as claimed in independent claims 13 and 21). After the file is downloaded to the server, then the recipient user is called and the downloaded file is transmitted to him/her (310 and 320, Fig. 3; page 8 line 177-page 9 line 202). There is no interaction from the recipient with the downloading of the file from the sender to the television server and therefore, he/she cannot authorize or end the downloading. The recipient can only interact with the transmission of the downloaded file from the server to his/her television (Specification, page 9 lines 196-202).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims **6-11, 13-15 and 19-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansson et al. (hereinafter 'Hansson', of record, WO97/47119) in view of Katz (Pub. No. 2006/0215029) in further view of Levitan (Patent No. 6,698,023).

Regarding claim 21, Hansson discloses a method of transmitting an audio / visual (A/V) file from a sender to a recipient using a voice communication network and a data network (Hansson: page 19 lines 25-30, page 20 lines 1-2; page 23 lines 28-31, page 24 lines 1-26. What is transmitted can be displayed on a TV set or anything with displaying capabilities by tapping a TV channel, page 24 lines 12-23), said voice communication network independent of said data network (PSTN 16 and Internet 14, Figs. 1, 4,5,7, 10 and 11, respectively), the method comprising the steps of:

establishing a voice connection on said voice communication network between said sender and said recipient, said recipient having a voice communication network address (telephone #, see page 15, lines 13-page 17, lines 23; page 16, line 1-4; and page 23, Fig. 9, lines 27-31 ; for example user A makes a voice call to user B's phone number);

determining a recipient data network address based on an association between said recipient data network address and said recipient's voice communication network address (telephone #) (as disclosed at page 4, lines 23-25; page 12, lines 20-page 13, lines 25, page 15, lines 11-25 and Fig. 9, page 23, lines 28-page 24, lines 5, Hansson clearly explains how the telephony server 15 creates a dynamic relation between the IP address of the IP modem and the telephone number of user within the access network

when the telephone server 15 receives an incoming call from an external network, i.e., PSTN or from an internal network, i.e., TV distribution network 8 of Fig. 9).

On the other hand, although Hansson teaches that information can be sent from sender to recipient and that video (TV channel) can be sent using this data network as explained above, Hansson does not explicitly teach receiving navigation instructions to navigate through said A/V information from said recipient via said voice connection.

However, in an analogous art, Katz teaches using devices that are able to control the display of received video by using the keypad of the telephone while connected with the sender ([0083]-[0085]).

Therefore, it would have been obvious to an ordinary skilled in the art at the time of the invention to modify Hansson's invention by using telephones that allow control the navigation of the received video as taught by Katz for the benefit of giving the convenience to the user of not using another device with extra buttons to press (remote control) to control the received video while it can be done with the already in use phone keypad or for giving both sender and recipient able to experience of real-time interactive in which the sender able to share the control of the recipient TV device (Baechle, reference of record, Col. 1, lines 45-55).

Additionally, although Hansson teaches that the NT 5 can be supplemented with a server (page 24, lines 24-26), the combined teachings of Hansson and Katz do not explicitly teach downloading said A/V file from said sender to a server associated with the recipient data network address via said data network.

However, in an analogous art, Levitan teaches a system using different types of networks (internet and TV Network, Fig. 2) where a/v files are downloaded to a television server (VTV server 12, Fig. 12) from the internet network and then, reformatted, broadcasted and presented to clients (15 and 16, Fig. 2) associated with the television server (abstract; col. 2 lines 49-64; col. 3 lines 3-7, lines 37-65; col. 4 lines 33-41).

Therefore, it would have been obvious to an ordinary skilled in the art at the time of the invention to have modified Hansson and Katz's invention with downloading the file at a server prior sending it to the recipient as taught by Levitan for the providing storage capabilities to the NT unit (Levitan, col. 7-10) in the case the user wants to save the file.

Regarding claim 6, receiving input from the recipient or sender; changing the information transmitted to the recipient data network address based on the input from the recipient or sender (Hansson, page24, lines 16-18. Katz: [0083]-[0085]).

Regarding claim 7, "wherein the input is a signal transmitted across the voice communication network," reads on the conversation between the caller and the recipient in which the caller/recipient (Hansson, page 23, lines 27-page 24, lines 23).

Regarding claim 8, "wherein the input is a signal transmitted across the data network" (Hansson, page 13, lines 25-page 15, lines 10).

Regarding claim 9, wherein the signal is a DTMF (Hansson, page 19, lines 5-8).

Regarding claim 10, Official Notice is taken for the signal being a voice command. The use of a voice command is notoriously known in data communication art (i.e. the user could say "Call 555-5555" and the system will recognize the command using the speech recognition and place a call using the stated phone number.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hansson and Katz's invention to use voice commands so to provide to user a friendly device that presents to users options that are easily to understand as similar to the options provided by conventional voice mail.

Regarding claim 11, wherein the sender is an automated interactive response system (Hansson, Fig, 9; PC 2).

Claim 13 was analyzed with respect to method claim 21.

Regarding claim 14, "means for initiating the connection on the voice communication network", (Hansson, page 15, lines 13-25).

Regarding claim 15, "wherein the means for downloading is initiated by means for sending a signal to said server, said server attached to the data network and



capable of transmitting the file to the recipient data network address” (Hansson, page 15, lines 1-10 and page 23, lines 28-page 24, lines 25).

Regarding claim 19, wherein the voice communications network address is a telephone number (Hansson, page 13, lines 9-12).

Regarding claim 20, " wherein the A/V file is adapted for rendering on a television screen (Hansson, page 24, lines 20-22. Levitan: abstract; col. 2 lines 49-64; col. 3 lines 3-7, lines 37-65; col. 4 lines 33-41).

7. Claims **2-5, 12 and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansson et al. (hereinafter ‘Hansson’, of records, WO 97/47119) in view of Katz (Pub. No. 2006/0215029) in view of Levitan (Patent No. 6,698,023) in further view of Ludwig et al. (hereinafter ‘Ludwig’, Pub. No. 2007/0168426).

Regarding claim 2, the combined teachings of Hansson, Katz and Levitan teach “wherein the downloading begins after the recipient authorizes the downloading” reads on the fact that both the caller and the recipient are connected through the phone for after the connection is made between the caller and the recipient through the telephone network, thereby authorizing the transmitting to the caller. As such the caller initiates a message/information to the recipient through the CATV network 8 (Hansson, page 24, lines 7-23, when ‘downloading’ refers to the transmission from the server to the

recipient). On the other hand, Hansson, Katz and Levitan do not explicitly teach that the recipient authorizes the downloading (when 'downloading' refers to sending the video from sender to the server).

However, in an analogous art, Ludwig teaches a system that lets a system that lets a user share files (including a/v files, [0048], [0052]-[0057]) and store them on a server for a recipient to see the on real-time or at a later time, or for real-time manipulation ([0068]; [0070]-[0072]; [0168]; [0176]; [0184]-[0185]). For anything to be sent to a recipient, it is needed that the recipient is logged in to the system (1, Fig. 23; [0140]-[0143]). In other words, the recipient authorizes any transaction (start and finishing of the downloading –from sender to server-) by being logged in the system.

Therefore, it would have been obvious to an ordinary skilled in the to have modified Hansson, Katz and Levitan's invention with the authorization of the transaction through a logging in of the recipient as taught by Ludwig for the benefit of not consuming storage capacity of the server with content for recipients that may not even be authorized to receive or be part of the network.

Regarding claim 3, "wherein the recipient authorizes the downloading by remaining on the voice connection for a designated period of time" reads on the connection is done between two devices by per session; thus when the session is terminated by an "on hook", the connection is terminated (Hansson, page 17, lines 18-24).

Regarding claim 4, “wherein the recipient authorizes the downloading by transmitting a signal across the voice communication network after the voice connection has been established” reads on the recipient answers the call (Hansson, page 18 lines 6-8).

Regarding claim 5, “wherein the recipient authorizes the downloading by transmitting a signal across the data network after the voice connection has been established” reads on the recipient answers the call, as disclosed on page 18, lines 6-8, using Internet telephony (Hansson, page 22, lines 4-11).

Regarding claims 12 and 16, the combined teachings of Hansson, Katz and Levitan teach “further comprising the step of ending the downloading of the A/V file to the recipient data network address when the voice connection between the sender and the recipient ends” reads on the connection is done between two devices by per session; thus when the session is terminated by an “on hook”, the connection is terminated (Hansson, page 17, lines 18-24, when ‘downloading’ refers to the transmission from the server to the recipient). On the other hand, Hansson, Katz and Levitan do not explicitly teach “further comprising the step of ending the downloading of the A/V file to the recipient data network address when the voice connection between the sender and the recipient ends” (when ‘downloading’ refers to sending the video from sender to the server).

However, in an analogous art, Ludwig teaches a system that lets a system that lets a user share files (including a/v files, [0048], [0052]-[0057]) and store them on a

server for a recipient to see the on real-time or at a later time, or for real-time manipulation ([0068]; [0070]-[0072]; [0168]; [0176]; [0184]-[0185]). For anything to be sent to a recipient, it is needed that the recipient is logged in to the system (1, Fig. 23; [0140]-[0143]). In other words, the recipient authorizes any transaction (start and finishing of the downloading –from sender to server-) by being logged in the system.

Therefore, it would have been obvious to an ordinary skilled in the to have modified Hansson, Katz and Levitan's invention with the authorization of the transaction through a logging in of the recipient as taught by Ludwig for the benefit of not consuming storage capacity of the server with content for recipients that may not even be authorized to receive or be part of the network.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMAR PARRA whose telephone number is (571)270-1449. The examiner can normally be reached on 9-6 PM schedule (M-F, every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OP

/Christopher Grant/

Supervisory Patent Examiner, Art Unit 2623